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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,398	11/10/2003	Shutsung Liao	10634-002002 / UCHI 751	4394
26161	7590	01/09/2006	C	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BADIO, BARBARA P	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/705,398	<b>Applicant(s)</b> LIAO ET AL.	
	<b>Examiner</b> Barbara P. Badio, Ph.D.	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18,20-23,29,31-34,65 and 66 is/are pending in the application.  
     4a) Of the above claim(s) 23 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,20-22,29,31,32,34,65 and 66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/21/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

**First Office Action on the Merits of a RCE**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Status of the Application***

2. Claims 18, 20-23, 29, 31-34, 65 and 66 are pending in the present specification. Claims 23 and 33 stand withdrawn from further consideration as being drawn to a nonelected species.

***Claim Rejections - 35 USC § 102***

3. The rejection of claims 18, 21, 22, 29, 31 and 65 under 35 USC 102(b) over Riccio et al. is withdrawn.
4. The rejection of claims 18, 21, 22, 29, 31 and 65 under 35 USC 102(b) over McKee et al. is withdrawn.
5. Claims 18, 20-22, 29, 31, 32, 34, 65 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurosawa et al.  
  
Kurosawa et al. teach several bile acid derivatives such as 3 $\alpha$ ,6 $\alpha$ -dihydroxy-5 $\beta$ -cholest-24-en-26-oic acid (see the entire article, especially, page 476, Figure 1,

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compounds 1b-11b, see especially compound 3b). The compounds and compositions taught by the reference are encompassed by the instant claims.

6. Claims 18, 20-22, 29, 31, 32 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaiser (US 4,351,767).

Kaiser teaches several steroid derivatives such as 3 $\alpha$ ,6 $\alpha$ -dihydroxy-5 $\beta$ -cholest-24-ene (see the entire article, especially, col. 6, Example X). The compound and composition taught by the reference are encompassed by the instant claims.

#### ***Claim Rejections - 35 USC § 103***

7. **The rejection of claim 20 under 35 USC 103(a) over McKee et al. is withdrawn.**


#### ***Telephone Inquiry***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1617

BB  
January 6, 2006